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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,739	04/06/2001	Jim Reich	540606-2001	9745

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EXAMINER

RUDDOCK, ULA CORINNA

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 01/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,739

Applicant(s)

REICH, JIM

Examiner

Ula C Ruddock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 30 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Protest

1. A protest against issuance of a patent based upon this application has been filed under 37 CFR 1.291(a) on October 29, 2002. It is suggested that Applicant refer to MPEP 1900 for further clarification.

Election/Restriction

2. Applicant's election with traverse of Group I in Paper No. 6 is acknowledged. The traversal is on the ground(s) that searching both groups and that the restriction requirement is improper. These arguments are not found persuasive because the restriction requirement of Paper No. 4 sets forth two distinct and independent inventions. Furthermore, the two groups have acquired a separate status in the art as shown by their different classification.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1-7 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Marier et al. (US 5,994,245). Marier et al. disclose a laminated product that comprises a fibrous mat (abstract). The fibrous mat includes polyester fibers (col 3, ln 26-28). The fibrous mat may also comprise fibers with specific functions (col 3, ln 30-31). For example, fibers containing agents preventing fungus or bacteria growth such as an acetate fiber under the name MICROSAFE may be suitable (col 3, ln 44-50). It should be noted that MICROSAFE is a textile product comprising acetate fibers coextruded with Triclosan (col 1, ln 56-60 of Chan et al. (US 6,461,386)). The fibers prevent bad odors due to bacteria growth (col 5, ln 32). With regard to the intended use statements of claims 9-11, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

5. Claims 1-7 and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Svoboda et al. (US 6,158,253). Svoboda et al. disclose a foot sock comprising a corespun strand (col 6, ln 44-45). In a preferred embodiment, a suitable sheathing blend includes channeled polyester and an antimicrobial acetate fiber (col 7, ln 14-16). The antimicrobial fiber serves to control bacteria related odors (col 7, ln 20-21). A suitable antimicrobial fiber is MICROSAFE. It should be noted that MICROSAFE is a textile product comprising acetate fibers coextruded with Triclosan (col 1, ln 56-60 of Chan et al. (US 6,461,386)). With regard to the intended use statements of claims 9-11, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

6. Claims 1-7 and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Knieler et al. (US 6,160,196). Knieler et al. disclose antimicrobial wound coverings preferable made of a

mixture of hydrophobic fibers and fibers comprising the antimicrobial active compound (abstract). Suitable bacterial hydrophobic fibers include polyester fibers (col 2, ln 13-16). The antimicrobial fibers are acetate fibers such as MICROSAFE (col 3, ln 1-4). It should be noted that MICROSAFE is a textile product comprising acetate fibers coextruded with Triclosan (col 1, ln 56-60 of Chan et al. (US 6,461,386)). In Example 1, the knitted fabric is produced from a thread which is composed of 80% polyester fibers and 20% MICROSAFE fibers (col 3, ln 31-37). With regard to the intended use statements of claims 9-11, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

7. Claims 1-7 and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Denesuk et al. (US 6,196,156). Denesuk et al. disclose bedding articles possessing microbe-inhibiting properties. The lining or cover is manufactured using materials derived from polyester fibers. Portions of the fabric may be constructed of acetate fibers. Some fraction of the materials are incorporated with micro-inhibiting agents such as Triclosan (col 10, ln 18-27). With regard to the intended use statements of claims 9-11, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

8. Claims 1-7 and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Denesuk et al. (US 6,240,879). Denesuk et al. disclose amusement articles possessing microbe-inhibiting properties. The fibrous batting is made of polyester, cellulose acetate, triacetate fibers, and blends thereof. The microbe-inhibiting agent is applied to at least a portion of the fibers in the fibrous batting (col 3, ln 32-38). The microbe-inhibiting agent is Triclosan (col 9, ln 41 and 58). With

regard to the intended use statements of claims 9-11, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marier et al. (US 5,994,245), as shown above. Marier et al. disclose the claimed invention except for the teaching that the acetate fiber is at least about 25% by weight of the total fabric. It should be noted that increasing the amount of antimicrobial acetate fiber in the fabric is a result effective variable. The larger the amount of antimicrobial acetate fiber in the fabric directly affects the antimicrobial property of the fabric. As a result, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used 25% acetate fibers in Marier's fabric, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have optimized the amount of acetate fiber in the fabric motivated by the desire to obtain a fabric with increased antimicrobial properties.

11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Svoboda et al. (US 6,158,253), as shown above. Svoboda et al. disclose the claimed invention except for the teaching that the acetate fiber is at least about 25% by weight of the total fabric. It should be noted that increasing the amount of antimicrobial acetate fiber in the fabric is a result effective variable. The

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larger the amount of antimicrobial acetate fiber in the fabric directly affects the antimicrobial property of the fabric. As a result, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used 25% acetate fibers in Svoboda's fabric, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have optimized the amount of acetate fiber in the fabric motivated by the desire to obtain a fabric with increased antimicrobial properties.

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knieler et al. (US 6,160,196, as shown above. Knieler et al. disclose the claimed invention except for the teaching that the acetate fiber is at least about 25% by weight of the total fabric. It should be noted that increasing the amount of antimicrobial acetate fiber in the fabric is a result effective variable. The larger the amount of antimicrobial acetate fiber in the fabric directly affects the antimicrobial property of the fabric. As a result, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used 25% acetate fibers in Knieler's fabric, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have optimized the amount of acetate fiber in the fabric motivated by the desire to obtain a fabric with increased antimicrobial properties.

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denesuk et al. (US 6,196,156), as shown above. Denesuk et al. disclose the claimed invention except for the teaching that the acetate fiber is at least about 25% by weight of the total fabric. It should be noted that increasing the amount of antimicrobial acetate fiber in the fabric is a result effective variable. The larger the amount of antimicrobial acetate fiber in the fabric directly affects the antimicrobial property of the fabric. As a result, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used 25% acetate fibers in Denesuk's fabric, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In the present invention,

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one would have optimized the amount of acetate fiber in the fabric motivated by the desire to obtain a fabric with increased antimicrobial properties.

14. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denesuk et al. (US 6,240,879), as shown above. Denesuk et al. disclose the claimed invention except for the teaching that the acetate fiber is at least about 25% by weight of the total fabric. It should be noted that increasing the amount of antimicrobial acetate fiber in the fabric is a result effective variable. The larger the amount of antimicrobial acetate fiber in the fabric directly affects the antimicrobial property of the fabric. As a result, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used 25% acetate fibers in Denesuk's fabric, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have optimized the amount of acetate fiber in the fabric motivated by the desire to obtain a fabric with increased antimicrobial properties.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Emi et al. (US 4,784,909) is believed to be pertinent because it discloses an anti-fungus, deodorant fiber material, but fails to disclose a fiber combination of polyester and acetate fibers.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C Ruddock whose telephone number is 703-305-0066. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

UCR *UCK*
January 13, 2003

Ula Ruddock